REMARKS

Claims 1 – 20 and 22 – 36 remain in the application and stand finally rejected. Claim 21 is previously canceled. Claims 1, 3, 4, 29 and 30 are amended herein. Although this Response is being timely filed, the Commissioner is hereby authorized to charge any fees that may be required for this paper or credit any overpayment to Deposit Account No. 19-2179.

Claims 1 and 29 are amended herein to indicate that the selected hand-over device is selected in cooperation with the mobility server. This is neither shown or suggested by any reference of record and supported in the specification, e.g., on page 5, lines 26 – 32. Claim 3 is amended by this proposed amendment to include steps directed at giving priority to handing off to another WLAN. Claims 4 and 30 are amended to include a recitation indicating that the mobility server maintains a connection to the call after the handover, which may continue even if connection to the WLAN device is lost. This also is neither shown or suggested by any reference of record and supported in the specification, e.g., on page 7, lines 16 – 18. No new matter is added.

Claims 1, 16 and 29 are finally rejected under 35 USC §102(e) as being unpatentable over U.S. Patent No. 6,584,316 to Akhteruzzaman et al. Claims 1 – 17, 19, 20, 22 – 25 and 27 – 36 are finally rejected under 35 USC §103(a) as being unpatentable over U.S. Patent No. 6,327,470 to Ostling in view of Akhteruzzaman et al. Claims 1 – 19 and 25 – 36 are finally rejected under 35 USC §103(a) as being unpatentable over published U.S. Patent Application No. 2002/0085516 to Bridgelall in view of Akhteruzzaman et al.

The final Office action responds to applicants arguments in the prior response, asserting that "Akhteruzzaman discloses that the first call device is a wireless terminal operating in a wireless telephone network. It is inherent in the art that such terminals can operate in a WLAN."

"There is no requirement that a person of ordinary skill in the art would have recognized the inherent disclosure *at the time of invention*, but only that the subject matter is in fact inherent in the prior art reference." MPEP 2112 II. (emphasis original).

Akhteruzzaman et al. references a "wireless intelligent network 56" twice and only twice, at col. 3, line 55 and col. 4, lines 13 – 14; and, represents it a single time in Figure 1. A mention of a "wireless intelligent network 56" hardly constitutes an inherent disclosure of a WLAN telephones in Akhteruzzaman et al. That one could today attach a WLAN phone to the Akhteruzzaman et al. "wireless intelligent network 56" is irrelevant to what Akhteruzzaman et al. inherently discloses. Accordingly, for such an inherent disclosure, it must be shown that WLAN telephones were "inherent in the art," not when the present application was filed, but at least by May 5, 2000, the filing date of Akhteruzzaman et al. No such showing has been made. Accordingly, inherent disclosure in Akhteruzzaman et al. of a "wherein at least one of said first call device and said set of target hand-over devices supports wireless local area network (WLAN) communications" has not been established.

Furthermore, in an Akhteruzzaman et al. system "[t]elephone calls are handed off from a wireless network to a wireline network under the control of a subscriber." Abstract, lines 1 – 2. "If the subscriber wants to transfer a call to a wireline terminal, ... the call is transferred to the designated wireline terminal using the local cellular network and **the wireless call is terminated.**" Id, lines 9 – 17 (emphasis added). Thus, Akhteruzzaman et al. teaches not maintaining a connection to the call after the handover, i.e., away from claims 4 and 30 as amended. Also, Akhteruzzaman et al. is very specifically concerned with "handing off of telephone calls from a wireless network to a traditional wireline network either automatically or under the control of the subscriber." Col. 2, lines 5 – 8. Furthermore, "[i]t is in the unique operation of the subscriber mobile terminal 70 and MSCs 66a, 66b and 66c that the present invention resides." The Akhteruzzaman et al. wireless subscriber mobile terminal manages the handover. Col. 5, line 25 – col. 6, line 25. "The wireless terminal's controller 30a at step 106 then determines if there is an existing directory number **stored** in the **terminal's memory** 30b ... ." Col. 6, lines 8 – 11 (emphasis added). Therefore, Akhteruzzaman et al. describes the subscriber mobile terminal 70 handing over from a wireless cellular network (MSCs 66a, 66b

and 66c) to a wireline network. Thus, again, Akhteruzzaman et al. teaches away from claims 4 and 30 as amended

By contrast "[t]he present invention relates generally to wireless Local Area Networks (WLAN), and specifically, to a method and an apparatus for automatically handing over calls between a WLAN and a non-WLAN." Page 1, lines 4 – 6. Thus, the WLAN device recited in independent claims 1 and 29 is not just incidental to the disclosure as the "wireless intelligent network 56" appears to be to the Akhteruzzaman et al. system. *See, e.g.*, claim 1, lines 6 – 7 and claim 29, lines 3 – 5 and 13 – 14. In particular, nowhere does Akhteruzzaman et al. teach a "mobility server that ... establishes a connection to said target device upon acceptance of said call by said target device." Claim 29, lines 13 – 14. Therefore, Akhteruzzaman et al. fails to teach the present invention as recited in claims 1, 16 and 29. Entry of the amendment, reconsideration and withdrawal of the final rejection of claims 1, 16 and 29, under 35 U.S.C. §102(e) is respectfully requested.

Regarding the final rejection of claims 1 – 17, 19, 20, 22 – 25 and 27 – 36 over Ostling in view of Akhteruzzaman et al., Ostling is relied upon to teach, essentially, all aspects of the invention, except it is acknowledged that Ostling fails to specifically teach defining a set of target hand-over devices.

Ostling teaches a "telecommunications system and method for performing a handover between the fixed (wireline) network and a mobile network during a call placed to or from a dual mode device, without any interruption in the voice or data connection." Abstract, lines 1 – 4. "Dual mode phones, which are cordless phones connected to both the fixed network 29 and a mobile network 10, e.g., GSM, PCS, or an analog system, are currently being developed to enable a subscriber to have only one phone to handle both fixed and mobile calls." Col. 3, lines 43 – 45. Applicants could identify nothing in Ostling to even refer to a WLAN. Very clearly here, the wireless network is a cellular network. *See, e.g.*, Figure 1, elements 10 – 26.

Additionally, the applicants note that the IEEE 802.11 working group approved the WLAN standard in 1997 with data rates of 1 and 2 Mbps. See, e.g., "802.11 History,"

www.fts.gsa.gov/webcast/3-7_wireless_security/tsld003.htm. WLAN phones of which the applicant is aware are 802.11a or 802.11b device. IEEE 802.11a and b were not promulgated until 1999. *Id.* Ostling was filed November 7, 1997, more or less coincident with legacy 802.11. Thus, there is nothing in Ostling to indicate that the Ostling wireless network is anything more than a cellular network, especially since Ostling was filed at a time when a WLAN was a rarity.

Therefore, combining Ostling with Akhteruzzaman et al. still results in a cellular network with wireless cell phones handing over to wired networks. Moreover, since Akhteruzzaman et al. teaches storing alternate numbers in the Akhteruzzaman et al. mobile device, combining Ostling with Akhteruzzaman et al., still falls short of what is recited in claims 1 or 29, as amended, or any claims depending therefrom.

Furthermore, since dependent claims include all of the differences with the references as the claims from which they depend, claims 2 – 15, 17 – 20, 22 – 28 and 30 – 36, which depend from claims 1 and 29, are patentable over Akhteruzzaman et al. with Ostling, alone, or further in combination with any other reference of record. Entry of the amendment, reconsideration and withdrawal of the final rejection of claim 1 – 15, 17 – 20 and 22 – 36 under 35 U.S.C. §103(a) is respectfully requested.

Similarly, regarding the final rejection of claims 1 – 19 and 25 – 36 over Bridgelall in view of Akhteruzzaman et al., Bridgelall also is relied upon to teach, essentially, all aspects of the invention, except it is acknowledged that Bridgelall fails to specifically teach on-demand hand-over devices. While, applicants do not necessarily accept that Akhteruzzaman et al. teaches this feature, neither Akhteruzzaman et al. nor Bridgelall teaches storing alternate numbers anywhere other than in the mobile device. If the numbers are in the mobile device, there is no reason to define them with the mobility server or have the mobility server provide them for pre-selection as claims 1 and 29 are amended to recite. Therefore, combining Bridgelall with Akhteruzzaman et al., also falls short of claims 1 or 29, as amended. Moreover, since dependent claims include all of the differences with the references as the claims from which they depend, claims 2 – 19, 25 – 28 and 30 – 36, which depend from claims 1 and 29, are patentable over the combination of Akhteruzzaman et al. with Bridgelall, alone, or further in

combination with any other reference of record. Entry of the amendment, reconsideration and withdrawal of the final rejection of claim 1 – 19 and 25 – 36 under 35 U.S.C. §103(a) is respectfully requested.

The applicants thank the Examiner for efforts, both past and present, in examining the application. Believing the application to be in condition for allowance, both for the proposed amendment to the claims and for the reasons set forth above, the applicants respectfully request that the Examiner, enter the amendment, reconsider and withdraw the final rejection of claims 1 – 20 and 22 – 36 under 35 U.S.C. §§102(e) and 103(a) and allow the application to issue.

> Again the applicants note that MPEP §706 III provides in pertinent part that
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> If **the examiner** is satisfied after the search has been completed that patentable subject matter has been disclosed and the record indicates that the applicant intends to claim such subject matter, he or **she may note** in the Office action that **certain aspects or features** of the patentable invention have not been claimed and that if properly claimed such claims **may be given favorable consideration.**

(emphasis added.)The applicants believe that the written description of the present application is quite different than and not suggest by any reference of record. Accordingly, should the Examiner believe anything further may be required, the Examiner is requested to contact the undersigned attorney by telephone at (650) 694-5339 for a telephonic interview to discuss any other changes.

Respectfully submitted,

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